A **SENG KONG SHUTTER INDUSTRIES SDN BHD & ANOR**

v.

SKB SHUTTERS MANUFACTURING SDN BHD

B

COURT OF APPEAL, PUTRAJAYA
HISHAMUDIN MOHD YUNUS JCA
AZIAH ALI JCA
MOHTARUDIN BAKI JCA
C [CIVIL APPEAL NO: W-02-3099-2010]
11 MARCH 2014

INTELLECTUAL PROPERTY: *Patent - Infringement - Validity of patent - Anticipation and novelty - Whether respondent's patent*
D *anticipated by existence of prior art*

INTELLECTUAL PROPERTY: *Patent - Inventive step - Whether invention obvious to person skilled in art - Whether person skilled in art must possess relevant common knowledge in roller shutter industry - Whether respondent's patent similar to prior art*
E

The appellants ('Seng Kong') appealed against the decision of the High Court which allowed the respondent's ('SKB') claim against Seng Kong for infringement of its patent entitled Rolling Door which was marked and promoted under the name SKB Vision 7.
F Seng Kong challenged the validity of SKB's patent and contended that SKB's patent was neither novel nor new because the invention of SKB's patent had been anticipated by the public availability in the market, prior disclosure and use of prior art. To support its contention, Seng Kong produced and relied on three
G pieces of prior art, namely, the PVC Piece, US 305 Patent and the US 714 Patent ('the prior art/PVC Piece'). In the court below, Seng Kong submitted that the joining of the slat to the bracket using the male and female tongue method and the groove method and the pivotal hinging of panels using the interlocking
H scrolls were disclosed in the PVC Piece. The trial judge found that the invention of SKB's patent was different because SKB's patent involved an inventive step that was not obvious to a person skilled in the art. Therefore, the trial judge held that SKB's invention was novel and Seng Kong had failed to establish that SKB's
I patent had been anticipated. On appeal, Seng Kong argued that the accepted principle of law to assess if a prior art anticipated

the subject invention of a patent was to compare the features of the claims of the patent with the features of the prior art and not by comparing the product that was manufactured in accordance with the patent of the prior art (*General Tire & Rubber Co v. Firestone Tyre & Rubber Co Ltd & Ors* ('*General Tire*'s case'). Seng Kong further contended that the trial judge had erred by not adopting the correct approach as laid down in *Windsurfing International Inc v. Tabur Marine (Great Britain) Ltd* ('*Windsurfing*'s case') in assessing whether SKB's patent was obvious against the prior art/PVC Piece to show lack of inventive steps. Thus, it was Seng Kong's case that SKB's patent was invalid for lack of novelty or lack of inventive step and did not meet the patentability requirements under ss. 11, 14 and 15 of the Patents Act 1983 ('the Act').

Held (allowing appeal; setting aside judgment of the High Court)

Per Aziah Ali JCA delivering the judgment of the court:

(1) The correct approach to be adopted in order to determine whether SKB's patent had been anticipated by prior art was to compare the claims of SKB's patent that defined the invention against the prior art/PVC Piece. In arriving at the finding that Seng Kong had failed to establish that SKB's patent had not been anticipated by the prior art/PVC Piece, the trial judge had not referred to SKB's patent claims and compared it to the prior art. Therefore, the trial judge had not applied the correct approach as laid down in *General Tire*'s case. (paras 14 & 15)

(2) To secure a patent, novelty is a fundamental requirement. The object of SKB's invention was to resolve a problem found in existing roller doors that were used to secure business and shops. The PVC Piece did not contain clear and unmistakeable directions to do what the inventor claimed to have invented. The elements found in SKB's patent were found in the PVC Piece (*General Tire*, foll). Therefore, SKB's patent lacked novelty as it had been anticipated by the prior art/PVC Piece. As such, SKB's invention had not met the requirements of s. 14 of the Act to be patentable under s. 11 of the same Act. (paras 17, 25, 26 & 27)

(3) The concept in SKB's patent was common general knowledge in the field of mechanical engineering which would be obvious to a normally skilled but unimaginative addressee in the art (*Windsurfing*'s case). Conceptually, there was no difference between the tongue and groove method and inter-engaging curled scrolls found in the invention of SKB's patent and the prior art. Therefore, the claim for patent infringement had not been established. (paras 32 & 33)

Bahasa Malaysia *Translation Of Headnotes*

Perayu-perayu ('Seng Kong') merayu terhadap keputusan Mahkamah Tinggi yang membenarkan tuntutan responden ('SKB') terhadap Seng Kong bagi pelanggaran paten bertajuk Rolling Door yang ditandakan dan dipasarkan di bawah nama SKB Vision 7. Seng Kong mencabar kesahan paten SKB dan menegaskan bahawa paten SKB bukanlah sesuatu yang baru kerana rekacipta paten SKB telah dijangkakan di pasaran, dizahirkan dan adalah senicipta terdahulu. Untuk menyokong hujahannya, Seng Kong mengemukakan dan bergantung kepada tiga senicipta terdahulu iaitu PVC Piece, US 305 Patent dan US 714 Patent ('senicipta terdahulu/PVC Piece'). Di mahkamah bawahan, Seng Kong berhujah bahawa percantuman kepada bilah pendakap menggunakan kaedah-kaedah tanggam berlidah dan alur kepada panel engsel pangsi menggunakan skrol saling kunci telah didedahkan dalam PVC Piece. Hakim bicara mendapati bahawa rekacipta paten SKB adalah berbeza kerana paten SKB melibatkan langkah rekacipta yang tidak ketara kepada orang yang mahir dalam bidang seni. Oleh itu, hakim bicara memutuskan bahawa rekacipta SKB adalah baru dan Seng Kong telah gagal membuktikan bahawa paten SKB telah dijangka. Dalam rayuannya, Seng Kong menghujahkan bahawa prinsip undang-undang yang diterima untuk menilai sama ada seni yang direka sebelum ini telah dijangkakan dengan rekacipta paten adalah dengan membandingkan ciri-ciri tuntutan paten tersebut dengan ciri-ciri senicipta terdahulu (*General Tire & Rubber Co v. Firestone Tyre & Rubber Co Ltd & Ors* ('kes *General Tire*'). Seng Kong juga menegaskan bahawa hakim bicara terkhilaf kerana gagal menggunakan pendekatan yang betul seperti yang ditetapkan dalam kes *Windsurfing International Inc v. Tabur Marine (Great Britain) Ltd* ('kes *Windsurfing*') untuk menilai sama ada paten SKB jelas menunjukkan kekurangan langkah daya cipta berbanding dengan senicipta terdahulu/PVC Piece. Oleh itu, kes

Seng Kong adalah bahawa paten SKB tidak sah kerana kekurangan kebaharuan atau kekurangan langkah daya cipta dan tidak mematuhi keperluan kebolehpatenan di bawah ss. 11, 14 dan 15 Akta Paten 1983 ('Akta'). A

Diputuskan (membenarkan rayuan; mengenepikan penghakiman Mahkamah Tinggi) B
Oleh Aziah Ali HMR menyampaikan penghakiman mahkamah:

(1) Pendekatan yang betul untuk digunapakai bagi menentukan sama ada paten SKB telah dijangkakan oleh senicipta terdahulu adalah dengan membandingkan tuntutan paten SKB yang mendefinasikan rekacipta terhadap senicipta terdahulu/ PVC Piece tersebut. Dalam membuat dapatan bahawa Seng Kong telah gagal membuktikan bahawa paten SKB tidak pernah dijangkakan oleh senicipta terdahulu/PVC Piece, hakim bicara tidak merujuk kepada tuntutan paten SKB dan membandingkannya dengan senicipta terdahulu. Oleh itu, hakim bicara tidak menggunapakai pendekatan yang betul seperti yang ditetapkan dalam kes *General Tire*. C D E

(2) Untuk mendapatkan suatu paten, kebaharuan adalah satu keperluan asas. Objektif rekacipta SKB adalah untuk menyelesaikan masalah dalam pintu roller sedia ada yang telah digunakan untuk keselamatan perniagaan dan kedai-kedai. PVC Piece tidak mengandungi arahan yang jelas dan tersendiri untuk melakukan apa yang perekacipta mendakwa telah merekacipta. Elemen-elemen yang terdapat dalam paten SKB didapati dalam PVC Piece. Justeru, paten SKB kekurangan kebaharuan kerana ia telah dijangka oleh senicipta terdahulu/ PVC Piece tersebut. Oleh itu, rekacipta SKB tidak memenuhi keperluan s. 14 Akta untuk dipatenkan di bawah s. 11 Akta yang sama. F G

(3) Konsep dalam paten SKB adalah pengetahuan am dalam bidang kejuruteraan mekanikal yang akan menjadi ketara kepada seorang penerima mahir tetapi tidak imaginatif dalam rekacipta (kes *Windsurfing*). Dari segi konsep, tidak ada perbezaan di antara kaedah-kaedah tanggam berlidah dan alur dengan skrol melingkar saling menarik yang terdapat dalam ciptaan paten SKB dan senicipta terdahulu. Oleh itu, tuntutan untuk pelanggaran paten tidak dibuktikan. H I

A **Case(s) referred to:**
General Tire & Rubber Co v. Firestone Tyre & Rubber Co Ltd & Ors [1972] RPC 457 ***(foll)***
Siddell v. Vickers & Sons Ltd [1890] 15 App Cas 496 ***(refd)***
Technograph Printed Circuits Ltd v. Mills & Rockle y (Electronics) Ltd [1972] RPC 346 ***(refd)***
B *Windsurfing International Inc v. Tabur Marine (Great Britain) Ltd [1985] RPC 59* ***(foll)***

Legislation referred to:
Patents Act 1983, ss. 11, 12, 13, 14, 15, 16, 31(1), 56(2)(a)

C **Other source(s) referred to:**
Terrell On The Law of Patents, 15th edn, p 199

For the appellant - Ambiga Sreenevasan (Janini Rajeswaran with her); M/s Ranjit Singh & Yeoh
D *For the respondents - Eow Khean Fatt; M/s Shen, Eow & Partners*

[Editor's note: For the High Court judgment, please see SKB Shutters Manufacturing Sdn Bhd v. Seng Kong Shutter Industries Sdn Bhd & Anor [2011] 4 CLJ 93.]

E *Reported by Sandra Gabriel*

JUDGMENT

F **Aziah Ali JCA:**

[1] The appellants' appeal against the decision of the High Court which allowed the respondent's claim against the appellants for infringement of Patent No. MY-128431-A ("MY Patent") entitled "Rolling Door" ("the plaintiff's Patent"). For the purpose
G of this judgment the parties will be referred to as they were in the court below; that is to say, the appellants will be referred to as the 'defendants', whilst the respondent will be referred to as the 'plaintiff'.

H **Brief Background Facts**

[2] The plaintiff, SKB Shutters Manufacturing Sdn Bhd is in the business of manufacturing, distributing and dealing in roller shutters, roller doors and a wide range of shutters. The plaintiff is
I the registered proprietor of the MY Patent. The plaintiff manufactures and distributes roller doors and roller shutters (exh. P2) that incorporates the invention under the said MY Patent which are marketed and promoted under the name 'SKB

VISION 7' (see pp. 431-450 appeal record). The plaintiff is also the registered owner of Trade Mark Registration No. 98009483 'SKB VISION 7' in Malaysia for goods and services in class 6.

[3] The first defendant, Seng Kong Shutter Industries Sdn Bhd is also in the business of dealing with roller shutters and other related products. The second defendant, Tan Kooi Lim is a director and shareholder of the first defendant.

The Claim

[4] The plaintiff's claim against the defendants is for patent infringement. The plaintiff alleges that while the plaintiff's patent is valid and subsisting, the defendants infringed the said patent by making, selling, offering to sell and using, without the consent or licence of the plaintiff, products that incorporated features of the said patent (exhs. P3 and P5 at pp. 451-456 appeal record).

The Defence

[5] By way of defence to the claim for patent infringement, the defendants challenged the validity of the plaintiff's patent. The defendants contended that the plaintiff's patent is neither novel nor new because the invention of the plaintiff's patent had been anticipated by the public availability in the market and prior disclosure and use of prior art at the point in time before the filing of the plaintiff's patent on 24 February 1997. In support of its contention, the defendants produced and relied on three pieces of prior art ("the Prior art"), namely:

(a) PVC aluminium piece ("the PVC Piece") marked as exhs. D12 and D18 which had been sold in the market since 1996, which is prior to the date of application of the plaintiff's patent on 24 February 1997 (p. 546 appeal record);

(b) United States Patent 5,456,305 ("US 305 Patent") marked as exh. D25 which was filed on 18 January 1995 and published prior to 24 February 1997 (p. 527-532 appeal record), and

(c) United States Patent 4,433,714 ("US 714 Patent") marked as exh. D26 which was filed on 23 October 1981 and published prior to 24 February 1997 (p. 533-540 appeal record).

[6] In the court below learned counsel for the defendants had submitted that the joining of the slat to the bracket using the male and female tongue method and the groove method and the pivotal

A hinging of panels using the interlocking scrolls are disclosed in the PVC Piece. Thus it is the defendants' case that the plaintiff's patent is invalid by reason of lack of novelty and/or lack of inventive step and does not meet all the patentability requirements, particularly ss. 11, 14 and 15 of the Patents Act 1983 ("the B Act"). It is further contended that the object of the plaintiff's patent was to increase the level of transparency of the roller shutter and to prevent the entry of small animals, cold and wind and rain. However the claims in the plaintiff's patent do not appear to solve these problems. For these reasons it is submitted C that the plaintiff's patent ought to be invalidated.

Decision Of High Court

[7] In considering the defendants' contention that the plaintiff's patent ought to be invalidated by reason of lack of novelty, the D learned judge referred to s. 14 of the Act which states as follows:

> Novelty
>
> 14. (1) An invention is new if it is not anticipated by prior art.
>
> E (2) Prior art shall consist of:
>
> (a) everything disclosed to the public, anywhere in the world, by written publication by oral disclosure, by use or in any other way, prior to the priority date of the Patent application claiming the invention;
>
> F
>
> (b) the contents of a domestic patent application having an earlier priority date than the Patent application referred to in paragraph (a) to the extent that such contents are included in the Patent granted on the basis of the said domestic Patent application.
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> G
>
> (3) A disclosure made under paragraph (2)(a) shall be disregarded:
>
> (a) if such disclosure occurred within one year preceding the date of the Patent application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title;
>
> H
>
> (b) if such disclosure occurred within one year preceding the date of the Patent application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title;
>
> I

(c) if such disclosure is by way of a pending application to register the Patent in the United Kingdom Patent Office as at the date of coming into force of this Act.

(4) Subsection (2) shall not exclude the patentability of any substance or composition, comprised in the prior art, for use in a method referred to in paragraph 13(1)(d), if its use in any such method is not comprised in the prior art.

[8] The learned judge acknowledged that s. 14 requires an invention to be new ie, it should not form part of the state of the art on the date of filing the patent application.

[9] On the issue of whether the plaintiff's patent has been anticipated, His Lordship referred to the case of *General Tire & Rubber Co v. Firestone Tyre & Rubber Co Ltd & Ors* [1972] RPC 457. In that case at the first instance, the attack on the patent concentrated on seeking to establish anticipation, obviousness and absence of any inventive step, and absence of sufficient and clear definition or ambiguity. The court was concerned with the issue of anticipation by prior publication, and according to the court, "the question whether the patentee's claim is new ... falls to be decided as a question of fact." (p. 485). In the judgment delivered by Sachs, LJ, His Lordship said *inter alia* as follows (p. 486):

> If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated ...
>
> To anticipate the patentee's claim the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented: ...

[10] The learned judge found that the PVC Piece does not contain clear and unmistakeable directions to do what the inventor claims to have invented in the plaintiff's patent. According to His Lordship the PVC Piece comprises of two physical parts as opposed to the subject invention of the plaintiff's patent which comprises three parts. There are no clear teachings or instructions that would lead a person skilled in the art to remove the links from the PVC Piece. The removal of the links in the PVC Piece would render the product completely unusable unless significant alterations are further made to the product. There must be a significant amount of tampering with the PVC Piece by cutting the

links of the single piece aluminium frame and altering it in order for it to be viewed as a three-part product. Thus any person intending to do so would be venturing into an inventive and exploratory effort. Therefore the learned judge found that the subject invention of the plaintiff's patent is substantially different because the plaintiff's patent involves an inventive step that is not obvious to a person skilled in the art. Consequently the learned judge disagreed with learned counsel for the defendants that the plaintiff's patent is not novel and lacked inventive step. The learned judge found that the plaintiff's claimed invention is novel and the defendants have failed to establish that the plaintiff's patent has been anticipated by the PVC Piece. The plaintiff's patent is therefore valid and the defendants have infringed the plaintiff's patent. Hence the learned judge allowed the plaintiff's claim of patent infringement.

The Appeal

[11] Before us it is submitted for the defendants that the accepted principle of law in assessing if a prior art in question anticipates the subject invention of a patent is by comparing the features of the claims of the patent with the features of the prior art (*General Tire & Rubber Co v. Firestone Tyre & Rubber Co Ltd & Ors*, *supra*). The correct test then is to compare the features of the plaintiff's patent claims with the features of the prior art/PVC Piece and not by comparing the product that is manufactured in accordance with the patent with the prior art. It is submitted that in the instant case His Lordship has erred by comparing the plaintiff's product with the prior art and this is evident by the observations made by His Lordship in his grounds of judgment that the PVC Piece comprises of two physical parts as opposed to the plaintiff's patent that has three parts.

[12] Learned counsel further submits that the trial judge has erred by not applying the correct approach in assessing whether the plaintiff's patent is obvious as against the prior art/PVC Piece to show lack of inventive step. Learned counsel cites the case of *Windsurfing International Inc v. Tabur Marine (Great Britain) Ltd* [1985] RPC 59 wherein Oliver LJ posed four questions as being the correct approach to be adopted for assessing non-obviousness. The approach to be adopted by the court is as follows:

(i) to identify the invention or concept in the patent suit;

(ii) to assume the mantle of the normally skilled but unimaginative addressee in the art at the relevant date and to impute to him what was at that date, common general knowledge in the art in question;

(iii) to identify what, if any, differences exist between the matters cited as being "known or used" and the alleged invention;

(iv) the court has to decide whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they required any degree of invention.

It is submitted that had the learned judge adopted the correct approach and accepted the evidence of DW3, Yap Mew Sang who is a mechanical engineer and an independent witness and who is skilled in the art as opposed to the evidence of PW1 Sin Kheng Lee, who is the managing director of the plaintiff and is also the inventor of the plaintiff's patent, then it is clear that the plaintiff's patent is obvious and lacks inventive step.

[13] For the plaintiff, learned counsel concedes that the prior art/PVC Piece has already existed at the time of the filing of the plaintiff's patent but submits that the correct test is to compare the plaintiff's product with the prior art. Learned counsel submits that the learned judge has correctly applied the approach as laid down in *Windsurfing International Inc v. Tabur Marine (Great Britain) Ltd (supra)* and has correctly rejected the evidence of DW3. It is submitted that the defendants have failed to show that the prior art has the same features as the plaintiff's product as the panels in the plaintiff's product do not interlock in the same way as the PVC Piece.

[14] With respect, we are unable to agree with learned counsel for the plaintiff that the learned judge has applied the correct test in considering the issues of novelty and anticipation. We agree with learned counsel for the defendants that, in considering the issue of whether the plaintiff's patent has been anticipated by prior art, the correct approach to be adopted is to compare the claims of the plaintiff's patent that defines the invention against the prior art/PVC Piece. In *General Tire & Rubber Co* cited by learned counsel for the defendants, Sachs LJ in his judgment at p. 485 said *inter alia* as follows:

> ... To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to **compare the earlier publication with the patentee's claim** ... If the earlier

A publication, so construed, discloses the same device as the device which the patentee by his claim, so construed, asserts that he has invented, the patentee's claim has been anticipated, but not otherwise. In such circumstances the patentee is not the true and first inventor of the device and his claimed invention is not new ... (emphasis added)

B

[15] We have perused the grounds of judgment of the trial judge and with respect, we find that in arriving at his finding that the defendants have failed to establish that the plaintiff's patent has not been anticipated by the PVC Piece, the learned judge has not C referred to the plaintiff's patent claims and compare it to the prior art. Instead, as rightly submitted by learned counsel for the defendants, the learned judge had compared the plaintiff's product with the PVC Piece. On this ground we agree with the defendants' contention that the learned judge has not applied the D correct approach as laid down in the case of *General Tire & Rubber Co (supra)*.

[16] Section 56(2)(a) of the Act states that the court shall invalidate the patent if the person requesting the invalidation E proves that what is claimed as an invention in the patent:

(a) is not an invention within the meaning of s. 12, or

(b) is excluded from protection under s. 13 or sub-s. 31(1), or

F (c) is not patentable because it does not comply with the requirements of ss. 11, 14, 15 and 16.

Novelty And Anticipation

[17] Newness is a requisite for patentability and it must be novel. G Therefore to secure a patent, novelty is a fundamental requirement (see ss. 11 and 14 of the Act).

[18] Novelty is not something which can be proved or established, only its absence can be proved or established. The H determination of novelty of an invention strictly consists of consideration of two aspects – the invention claimed for protection and the prior art information available in the concerned field. The knowledge of an invention in order to be considered as relevant prior art should satisfy any one or more of the following:

I

(a) by the description of the invention in a published writing or document or in any tangible form;

(b) by description of the invention in spoken words uttered in public, such a disclosure is known as oral disclosure;

(c) by the use of the invention in public or by putting the public in a position where any member of the public may access to it.

The test for establishing the lack of novelty is that each and every ingredient element of the claimed invention must be present in a single prior art. (see *Subbaram On Patent Law, Practices & Procedures* 2nd edn.).

[19] Proof that an invention is not new and lacks novelty because it has been anticipated by prior art constitutes a ground for the invalidation of such invention (s. 56(2) of the Act). The onus of proof lies, as regards each allegation, on the party launching the attack (*General Tire & Rubber Co*, *supra*).

[20] Reverting to the instant case, it is therefore necessary to examine the plaintiff's patent claims (pp. 379-398 appeal record) *vis-à-vis* the PVC Piece in order to determine whether the defendant has established that the PVC Piece anticipates the subject invention of the plaintiff's patent and thus the plaintiff's patent lacks novelty.

[21] There are 11 claims in the plaintiff's patent application (pp. 390-393 appeal record), however, learned counsel for the defendants, Dato' Ambiga, submits that the court need only to consider claim 1 which describes the basic invention, and claims 9 and 11. The other claims are, what learned counsel describes as, 'dependent claims'. For the purpose of demonstrating that the plaintiff's patent as described in claim 1 is not new and is anticipated by prior art and/or lacks novelty, the defendants produced before us the plaintiff's product (marked as "MY Patent") and the PVC Piece (exh. D12). The defendants have also produced diagrams/drawings to further assist the court to appreciate the features stated in claim 1 which the defendants claim are also found in the PVC Piece in order to show that the plaintiff's patent has been anticipated by prior art, is not novel, is obvious and lacks inventive step.

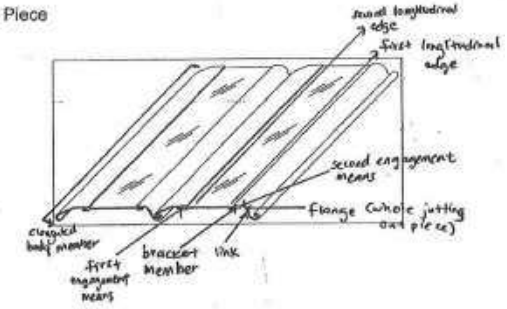
[22] As proposed by learned counsel for the defendants, we assessed the plaintiff's patent claim 1 to determine whether the defendant has established that the PVC Piece anticipates the plaintiff's Patent and therefore the plaintiff's patent lacks novelty.

[23] We take the liberty of reproducing below the plaintiff's claim 1 as summarised by learned counsel for the plaintiff at the High Court and reproduced in the learned judge's grounds of judgment, and the diagrams/drawings that were submitted to us during the appeal as follows:

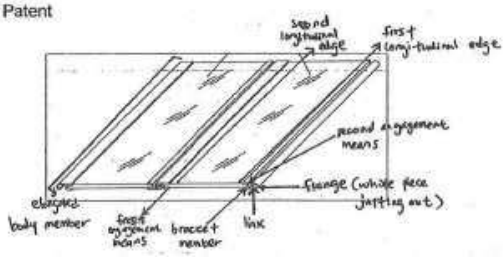
> Claim 1 - is essentially a panel suitable for use in a rolling door of the type, including a door curtain supported on a roller assembly for movement between open and closed position; comprising:
>
> (i) an elongated body member [21] (hereinafter the "Slat") having a first longitudinal edge [53] (hereinafter the "First Edge") and a second longitudinal edge [54] (hereinafter the "Second Edge");
>
> (ii) the first engagement means (hereinafter the "First Bracket") is positioned on the said First Edge and second engagement means (hereinafter the "Second Bracket") positioned on the said Second Edge, each arranged so as to engage complementary engagement means (hereinafter "Brackets") on an adjacent edge of another panel to link the panels and thereby form the said curtain door;
>
> (iii) the First and Second Brackets each comprises a bracket member [27,28] mounted on the First Edge or said Second Edge, as appropriate, and extending substantially along its length; and a flange [49,52] (hereinafter the "Flange") extending from the said bracket member substantially transversely to the said First Edge or said Second Edge, said Flange comprising a link portion [45, 46] and an engagement portion [47,48] (hereinafter the "Interlocking Scroll"), wherein the said Interlocking Scroll has a curved cross-section with a curvature suitable to engage the Interlocking Scroll of a Flange extending from a bracket member mounted on an adjacent edge of another panel;
>
> (iv) the said bracket member has a base [31,34], a first arm [29,33] and a second arm [30,32], each arm extending substantially transversely from the said base so that the said bracket member [27,28] is substantially U-shaped in cross-section.

Lack of Novelty

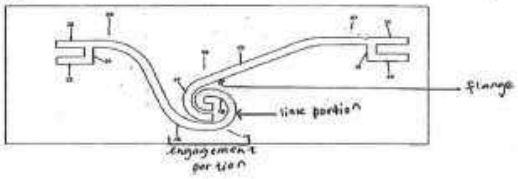
PVC Piece



MY Patent



PVC Piece



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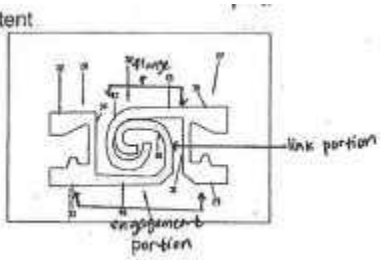
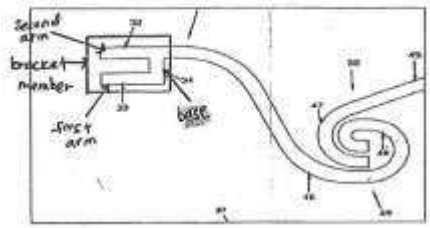


A

PVC Piece



B

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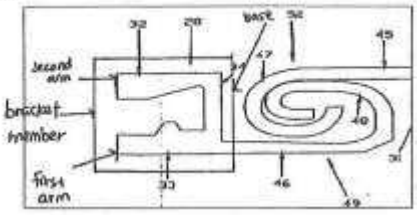
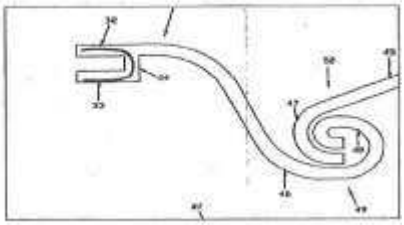
MY Patent



D

E

PVC Piece



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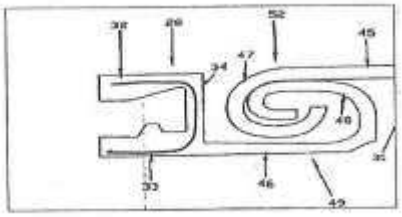
MY Patent



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[24] Learned counsel for the defendants submits that a comparison of the elements in claim 1 as against the PVC Piece shows that the elements in claim 1(i) to (iv) are all found in the PVC Piece. In respect of claim 9 it is submitted that this claim is inherently defective because it refers to itself. Claim 9 reads as follows:

> 9. A panel as claimed in claim 9 wherein the said plastics material is transparent.

With respect to claim 11 which states:

> 11. A panel suitable for use in a rolling door (50) of the type including a door curtain (51) supported on a roller assembly (50) for movement between open and closed positions; comprising an elongated body member (21) having a first longitudinal (53) and a second longitudinal edge (54);

it is submitted that the plaintiff's own expert witness PW2, Jeremy John Day who is a patent attorney, concedes that the prior art US Patent 305 is probably destructive of the novelty of claim 11 (p. 301 appeal record).

[25] We have perused the plaintiff's patent application (pp. 380-381 appeal record) in which it is stated that the object of the plaintiff's invention is to essentially resolve a problem found in existing roller doors that are used to secure businesses and shops. It was found that conventional roller doors are made of steel or aluminium which prevent potential customers from viewing the goods in the shop when the shop is closed. One approach is to use a roller door of extruded aluminium tubes arranged to form a grid to prevent intruders from gaining access into the businesses or shops but such door does not prevent the penetration of small animals which may damage the contents of the business or shop. Cold wind and rain may also cause damage to the stock in the businesses and shops. The plaintiff's invention recognises that it would be desirable to have a rolling door wherein the door curtain is formed of a transparent material and then provide an arrangement which allows such a door to be assembled.

[26] As we have observed earlier, and as found by the learned judge, the PVC Piece does not contain clear and unmistakable directions to do what the inventor claims to have invented. What is available is the PVC Piece itself. Adopting the approach as laid down in *General Tire & Rubber Co* (*supra*) we have assessed the

plaintiff's patent claim 1 which is the defining claim against the PVC Piece assisted by the diagrams/drawings produced. Having done so and having given considerable thought to what is before us, we agree with learned counsel for the defendants that all the elements found in the plaintiff's patent claim 1 are found in the PVC Piece.

[27] We agree with the defendants that the plaintiff's patent lacks novelty as it has been anticipated by the prior art/PVC Piece. We find that the plaintiff's invention has not met the requirements of s. 14 of the Act to be patentable under s. 11 of the same Act. The plaintiff's patent is thereby invalid.

[28] Having made our finding that the plaintiff's patent is invalid for lack of novelty, we are of the view that there is no necessity to proceed with the determination of whether the plaintiff's patent is obvious. However for the purpose of completeness we would venture to state that obviousness would cover practically every case of lack of novelty (*Technograph Printed Circuits Ltd v. Mills & Rockley (Electronics) Ltd* [1972] RPC 346). If any embodiment within the scope of the claim is obvious, then the claim is invalid (*Terrell On The Law Of Patents* 15th edn.). In *Siddell v. Vickers & Sons Ltd* [1890] 15 App Cas 496, Lord Herschell pointed out that obviousness connotes something which would at once occur to a person skilled in the art who was desirous of accomplishing the end.

Obviousness

[29] In considering whether the invention claimed is obvious and hence did not involve any inventive step to devise a product or process falling within the scope of the claim, the relevant comparison is not between the preferred embodiment of the invention claimed and the prior art. Rather the question to be asked is "to whom must the invention be obvious?". As to this question Lord Reid in *Technograph Printed Circuits Ltd v. Mills & Rockley (Electronics) Ltd (supra)* said as follows (p. 355):

> It is not disputed that the hypothetical addressee is a skilled technician who is well acquainted with the workshop technique and who has carefully read the relevant literature ... . When dealing with obviousness, unlike novelty, it is permissible to make a "mosaic" out of the relevant documents, but it must be a mosaic which can be put together by an **unimaginative man with no inventive capacity.**

> Whether or not it was obvious to take a particular step is a question of fact ... . But the question is not whether it is now obvious to the court ... but *whether at the relevant date it would have been obvious to the unimaginative skilled technician*. A thing which may now seems obvious to anyone may at that date have been far from obvious to him. (emphasis added)
>
> On this matter the evidence of experts is generally valuable and often necessary. Then, as in all matters where expert evidence is relevant, the court must weigh the expert evidence.

[30] The primary evidence is therefore that of an expert, who can give evidence as to the nature of the unimaginative skilled addressee, the body of knowledge (the so-called common general knowledge) which he would possess and the way in which such a skilled man would, as a matter of routine, approach problems. He can also identify steps which he believes would require a degree of lateral thinking and hence not be obvious to the skilled man. (*Terrell On The Law Of Patents* 15th edn.)

[31] We have considered the testimonies of PW1 who is the inventor of the subject of the patent and DW3 who is an engineer, an inventor and product and process designer. He is also an Exco member of the Malaysian Invention and Design Society. We are of the view that both PW1 and DW3 can hardly be described as "the unimaginative skilled addressee". However what can be gleaned from the evidence of PW1 is that the tongue and groove concept which is a method of joining two pieces of material together is a known concept in mechanical engineering. According to him through a lot of research and development he finally arrived at the particular shape for the tongue and groove for the plaintiff's patent which he says is different from other roller shutters. Thus on his evidence the invention or concept in his product is the shape of the tongue and groove. DW3 in his evidence confirmed that the plaintiff's patent employed the tongue and groove method which are elementary engineering concepts. Similarly with the concept of the interlocking scrolls and hinges. PW2 Jeremy John Day, in his answer to question no. 9 of his witness statement (p. 293 appeal record) states that "Conventionally, the panels of roller shutter doors are hingedly connected together by inter-connecting scrolls along their edge". In cross-examination PW2 agreed that the inter-engaging curled scrolls exists in prior art and that the male and female tongue and

A the groove joining method are common general knowledge. In re-examination PW2 again agreed that the tongue and groove method of joining two materials is common general knowledge in the field of mechanical engineering.

B **[32]** Guided by the approach to be adopted for assessing non-obviousness as laid down in *Windsurfing International Inc v. Tabur Marine (Great Britain) Ltd (supra)* we find from the evidence that the concept in the plaintiff's patent is common general knowledge in the field of mechanical engineering which would be obvious to C a normally skilled but unimaginative addressee in the art. Conceptually we find no difference between the concept of tongue and groove method and inter-engaging curled scrolls found in the subject invention of the plaintiff's patent and the prior art.

D **[33]** In *Terrell On The Law of Patents* 15th edn. it is stated at p. 199 as follows:

> It has been said that there cannot in any event be an infringement of an invalid patent. Thus Jacob J. said in *Organon Teknika v. Hoffman-La Roche* [1996] F.S.R. 383 at 386: "in English law E validity and infringement are part of the same questions. You cannot infringe an invalid claim, even if you fall within its language.

We respectfully adopt the same. We find that the plaintiff's claim against the defendants for patent infringement has not been F established. For the reasons stated we allow the appeal and set aside the judgment of the High Court in respect of the claim for patent infringement. We award costs of the appeal to the appellant as agreed in the sum of RM25,000. In respect of costs at the High Court we award the sum of RM50,000. The deposit G is refunded.

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